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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,517	07/31/2001	Takahiro Okada	P/1071-1422	3623

7590

08/06/2003

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EXAMINER

CHO, JAMES HYONCHOL

ART UNIT

PAPER NUMBER

2819

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/919,517

Applicant(s)

OKADA ET AL.

Examiner

James H. Cho

Art Unit

2819

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☒ Claim(s) 2-4, 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed July 1, 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Takeda et al. (US PAT No. 4,673,902).

Regarding claim 1, Fig. 9 of Takeda et al. teaches a dielectric filter comprising a dielectric block (RI); a plurality of conductive through holes (4a, 4b) arranged in the dielectric block, each of the conductive through holes having an open end (4a and 4b are open) along a first surface of the dielectric block (surface where 13 is placed); a respective coupling electrode (an electrically coupled electrode comprising 13a and 11k, and another electrically coupled electrode comprising 13b and 11k') connected to each conductive through hole (4a and 4b), each coupling electrode formed on the first surface of the dielectric block (surface where 13 is placed) and extended at least to a first edge of the dielectric block (11k and 11k' are extended to all edges of the first surface where 13 is placed), the coupling electrodes having a common and continuous, non-conductive gap (space between 13a and 13b) therebetween shared by the respective coupling electrodes and generating a capacitance therebetween so as to couple the plurality of conductive through holes (col. 6, lines 11-18); and an outer

Art Unit: 2819

conductor (outer conductor is shown in Fig. 5 with dotted pattern indicating a conductor) arranged on outer surfaces of the dielectric block.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 is rejected under 35 U.S.C. 102(b) as anticipated by Takeda et al. or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takeda et al. in view of Saito et al. (US PAT No. 5,764,118).

Regarding claim 5, Takeda et al. discloses the dielectric filter according to claim 1, but does not teach or fairly suggest a communication apparatus comprising a high-frequency circuit connected to the dielectric filter according to one of claims 1 and 2. However, this limitation appears to be merely a statement of intent of the dielectric filter. It has been held that a recitation directed to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

However, if the limitation regarding a communication apparatus a high-frequency circuit connected to the dielectric filter is not considered a mere statement of intended use, it is considered well-known in the art that a communication apparatus to be

Art Unit: 2819

constructed with a pair of dielectric filters as taught in Fig. 36 of Saito et al. (col. 13, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have constructed a communication apparatus having the dielectric duplexer of Saito et al. with a dielectric filter of Takeda et al. for the purpose of providing an antenna device, i.e. duplexer designed with two dielectric filters.

Allowable Subject Matter

Claims 2-4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 7 is allowable over the prior art of record.

The following is a statement of reasons for the indication of allowable subject matter: Although, Takeda et al. discloses a dielectric coaxial resonator, Takeda et al. differs from the present claimed invention because, among other things, Takeda et al. pertains to having electrodes coupled to conductive through holes whereas the present claimed invention pertains to the specifics of the electrodes further extended onto a second surface which intersects the first edge of the dielectric block, and the specifics of input/output electrodes placed on a second surface and extended from a second edge. Accordingly, one of ordinary skill in the art would not have been motivated to modify the teachings of Takeda et al. to meet the claimed limitation as set forth in the present claimed invention.

Response to Arguments

Art Unit: 2819

4. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Heine (US PAT No. 5,173,672) discloses a dielectric block filter with included shielded transmission line inductors.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

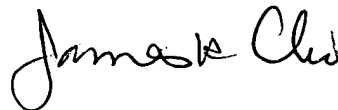
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2819

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Cho whose telephone number is 703-306-5442. The examiner can normally be reached on Monday-Friday, 05:30am-02:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Tokar can be reached on 703-305-3493. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



James H. Cho
Examiner
Art Unit 2819

July 28, 2003